

12/07/2006 THU 17:13 FAX

RECEIVED
CENTRAL FAX CENTER

DEC 07 2006

006/009

10/808,078
END5293USNP

Remarks

Status of Claims:

Claims 1-20 were rejected. Claims 4, 5, 14, and 20 have been amended.

Support for the amended claims is found in the specification and drawings as filed. No new matter is added. For instance, support for the amendment to Claim 4 and Claim 20 regarding the molded portion is found at paragraph [65]. Support for Claim 5 is found in the claims, as filed. Claim 14 is amended to correct a typographical error.

§103 Rejections

Claims 1-4 and 6-20 are rejected as obvious over Kumar et al. (US 2003/00289094) in view of Huitema et al. (U.S. Pat. No. 6,626,849). Claim 5 is rejected as obvious over Kumar et al. in view of Sapatova et al. (U.S. Pub. No. 2003/0203140). Applicant respectfully traverses these rejections for the following reasons.

The Examiner has mischaracterized the reference:

First, it is respectfully urged that the Examiner has misinterpreted the teachings of the cited references. For instance, the Examiner states that Kumar et al teaches

"...a proximal needle segment (1890 &1820) disposed proximally of the tissue receiving port..." page 2 of Examiner rejection

This is not a fair description of what Kumar et al. teaches. Kumar et al. at paragraph [0188] states that:

"As the plunger 1822 is pulled in a proximal direction, a *plastic clip* 1890 can compress the *spring* 1820." Italics added.

It is respectfully urged that Kumar et al. does not teach or suggest that elements 1890 or 1820 are a proximal needle segment. Instead, Kumar et al. discloses a plastic clip 1890 and spring 1820. It is respectfully urged that neither a clip or a spring is fairly characterized as being a needle segment.

Accordingly, the Examiner's rejection of Claims 1-4 and 6-20 is improper because the basis of this rejection is not supported by the actual teachings of Kumar et al.

No Motivation

Further, it is respectfully urged that one would not be motivated to modify Kumar et al. by the teachings of Huitema to obtain the claimed invention, because neither Kumar or Huitema remotely suggest that it would be advantageous or even possible to modify a spring or a clip to provide a substantially continuous lumen, as the Examiner seems to suggest.

Claim 1 recites, among other things:

a distal needle segment comprising a tissue receiving port, the distal needle segment formed of a first material that does not interfere with MRI imaging of a portion of the distal needle segment associated with the tissue receiving port; and

a proximal needle segment disposed proximally of the tissue receiving port, the proximal needle segment formed at least in part of a second material different from said first material;

wherein the proximal needle segment and the distal needle segment provide at least one substantially continuous lumen, wherein the proximal needle segment and the distal needle segment are longitudinally joined along a common axis.

The Examiner is respectfully urged to explain how the teachings in the prior art would motivate one to employ the spring or clip of cited reference to create a proximal needle segment and a distal needle segment that provide at least one substantially continuous lumen.

Under MPEP 2143, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicant submits that the combined art of record fails to render the amended claims obvious. In particular, Applicant notes that the combination of references fails to teach or suggest all of

10/808,078
END5293USNP

the limitations of each amended independent claim in accordance with MPEP 2143.03. In addition, Applicant submits that even if the combined art of record taught or suggested all of the limitations of each present independent claim, there is no teaching, suggestion, or motivation to modify or combine the references to obtain the invention presently claimed, such that a *prima facie* case of obviousness has not been, and cannot be, established in accordance with MPEP 2143.01.

Amended Claims 4 and 20:

Additionally, it is respectfully urged that the references, even if combined, would not teach or suggest the subject matter of Claim 4, as amended.

Amended Claim 4 and Amended Claim 20 each recite that a portion of the distal needle segment is molded over a portion of the proximal needle segment.

It is respectfully urged that neither Huitema or Kumar teach such a needle construction.

Claim 14 and Claim 15:

Claim 14 recites, among other things, that the needle comprises at least one passage extending from the vacuum lumen to an outer surface of the needle.

The Examiner states that Huitema teaches such a passage 36, but this is not a correct reading of Hultama. Huitema discloses a port 36 that communicates with the cutter lumen 32 of Huitema (see column 4, lines 26-34 of Huitema). The port 36 in Huitema does not provide a passage extending from the vacuum lumen to an outer surface of the needle.

Accordingly, the references do not teach the subject matter of Claim 14, or Claim 15, which recites a plurality of passages extending from the vacuum lumen to an outer surface of the needle.

Claim 16:

The Examiner rejects claim 16 as obvious based on paragraph 0079 of Kumar. It is respectfully urged that paragraph 0079 does not teach or suggest the subject matter of Claim 16.

12/07/2006 THU 17:14 FAX

4009/009

10/808,078
ENDS293USNP

Paragraph [0079] in Kumar states that a dipole antenna portion of the loopless antenna may be on the order of about 3 cm to about 20 cm in length, and may be a relatively small maximum outer diameter of about 0.3 mm to about 1.0 cm.

Claim 16 recites, in part,

a proximal needle segment formed at least in part of a metal, the proximal needle segment comprising a proximal cutter lumen portion, and wherein said metal is spaced proximally at least about 0.5 inch from a proximal edge of said tissue receiving port;

It is respectfully urged that the Examiner may not properly apply a teaching regarding antenna dimensions in Kumar to reject a claim directed to spacing of metal in a proximal needle segment from a tissue receiving port.

Withdrawal of the rejection is requested.

Claim 5:

It is respectfully urged that the rejection of Claim 5 as obvious over Kumar in view of Sapatova et al. should be withdrawn in view of the amendment of Claim 5, and in view of the arguments made above with respect to the patentability of Claim 1, from which Claim 5 depends.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

/Gerry Gressel/
Gerry Gressel, reg #34,342

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(513) 337-3535